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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,603	10/23/2001	Stephen H. Decatur	09469/070001; 94.0046	8192

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EXAMINER

BROOKS, MATTHEW L

ART UNIT	PAPER NUMBER
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3629

MAIL DATE	DELIVERY MODE
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02/20/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/004,603	Applicant(s) DECATUR, STEPHEN H.	
	Examiner MATTHEW L. BROOKS	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,7,11-14 and 16-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,7,11-14 and 16-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the Drawings are now objected to because the PRIOR newly amended claim language is not found with in the figures. Figures/flowcharts of the method steps and systems involved would greatly facilitate understanding of the claims. For instance “receiving through a website, a plurality of proposals” is not on flow chart, NOR is “ a first compensation” and many other claim limitations are not shown by way of figure or flow chart. The claimed language must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 7 and 11-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. With respect to claim 1, (note independent claim 7 has the same problems): the claim is listed below:

A method for developing a prospect on a property of an *interest owner*, comprising:

- (a) providing a first set of property information to a *prospect participant*;
- (b) providing a *compensation schedule to the prospect participant*,

The confusion arises in the intended meaning of the "interest owner" and that of a "prospect participant"; This is apparent because provide a first set of property information to a prospect participant and provide a compensation schedule to the

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prospect participant - does the applicant not mean providing a compensation schedule to the interest owner?

Furthermore with respect to the claims, (claim 1, limitation (c) for example), who or what is actually "receiving a proposal for prospecting the property from the prospecting participant"? The same can be said of limitation (f), who or what is providing the second set of property information?

For purposes of examination claim 1 and similar claim 7 are interpreted as follows:

A method for developing a prospect comprising:

- (a) an interested prospector has property information
- (b) the prospector has options on how to purchase or lease the property
- (c) the prospector makes his/her offer types
- (d) the owner evaluates the offer types
- (e) then the prospector receives owners choice of offer types
- (f) then the property owner gives the prospector a second set of property data
- (g) then experts look at the reports and determine if has gas or oil
- (h) then dig in the areas where the reports indicate there may be oil
- (i) then compensate the property owner based upon the deal.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 7 and 11-27 are rejected under 35 U.S.C. 101 because the claims have no particular machine claimed. Rather the claims are directed toward a series of steps/backroom dealings between several parties. This is not subject matter for patent. Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The machine-or-transformation test of *In re Bilski* is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. Certain considerations are applicable to analysis under either branch.

First, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity.

The present method as a whole are directed toward “developing a prospect”. The claims although tied generally to a computer are not tied to any “particular” machine, so the use of the computer is considered extra-solution activity. This is further evidenced by the facts of this application. When Examiner made an initial 101 rejection Applicant replied by including the limitation of that of a general “website”. So examiner must look to see if there is any transformation of a particular article. The only thing the

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claims attempt to change is that of the fundamental principle or abstract idea of developing a prospect.

“Purported transformations or manipulations simply of public or private legal obligations or relationships, business risks, or other such abstractions cannot meet the test because they are not physical objects or substances, and they are not representative of physical objects or substances.”

Applicants' process at most incorporates only such ineligible transformations. . . . the process as claimed encompasses the entering of data onto any computer then proposes to use this data to determine whether or not one is “develop a prospect”. Yet the manner in which this is achieved is not claimed with any particular guidance. Thus, the claims does not have the muster to be patent eligible.

NOTE: also see REMARKS 12/11/2008 page 11 wherein applicant argues compensation schedules are patent eligible subject matter.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1 and 7 and 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the public activities of petroleum place and its posted website www.petroleumplace.com as demonstrated by the attached packet of articles "Petroleumplace_ 2-12" (herein after PP).

First note that: Applicant states in response to the question what does your invention solve and summarize the prior practice? – that the solution allows applicant "to develop prospective exploration opportunities from a wide variety of individuals that are not employees" and "Prior practice has been to hire consultants".

Claim 1 and 7 and 11-19 are rejected under 35 U.S.C. 103 as being unpatentable over the PP reference. The PP discloses all of the on PP_11 for example an online portal that provides a clearinghouse/internet enabled transaction and brokerage services for the acquisition and divestiture of oil and gas properties... the service includes simultaneous floor and internet bidding at live auctions...exclusive online auctions, negotiated transaction services, data room administration, and engineering and geotechnical analysis/reports to support all divestiture processes. The other documents

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PP 1-10 and PP 12 fully support this and the other informational features normally provided by a online gas prospecting. PP does not discuss the exact wording of calling the payments "compensation schedule" nor calling the analysis tool results an "interpretation report" as claimed. In determining the obviousness of applying what is generally known in the "prospecting industry" to what is known in the world of the Internet one must determine the level of ordinary skill (*Dann v. Johnston*, 425 U.S. 219, 189 USPQ 257 (1976)). The Internet, to one ordinarily skilled in the art, for some time now is recognized as a vehicle in which information is shared from computer to computer. A typical example would be for one computer to access and download files from another computer located at a different site than the first. Platforms for carrying out such methods are widely known. Also, the oil industry *has utilized compensation schedules and reports analyzing seismic data for years to determine whether to dig on land and how to compensate owners of the land for rights to dig*. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have merely called the payments made compensation schedules and interpretation reports because fundamentally that is what they are.

Response to Arguments

8. Applicant's arguments with respect to claims 1 and 7 and 11-27 have been considered but are not persuasive.

Conclusion

9. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (571) 272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MLB
2/14/09

/John G. Weiss/
Supervisory Patent Examiner, Art Unit 3629